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In re Application of
NAKAJIMA, Kei *et al*
U.S. Application No.: 09/554,065
PCT No.: PCT/JP98/05057
Int. Filing Date: 10 November 1998
Priority Date: 10 November 1997
Attorney Docket No.: 05905.0108
For: CHARACTER COMMUNICATION
DEVICE

DECISION ON
PETITION UNDER 37 CFR
1.47(a)

This is a decision on applicants' "Response to Decision on Applicants' Petition Under 37 C.F.R. §1.47(a)" ("Ren.Pet.") filed 11 December 2001.

BACKGROUND

On 11 May 2001, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed because applicants failed to meet the requirements of item (2) and item (4) of 37 CFR 1.47(a).

On 11 December 2001, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a petition for a five-month extension of time and fee of \$1,960.00; a declaration signed by four of the five inventors; a declaration of Mr. Kouji Tsuchiya written in Japanese and English; and various copies of documentary evidence in support of applicants' claim that a diligent effort was made to locate Mr. Nakajima.

DISCUSSION

In the initial petition, applicants failed to fully satisfy item (2) and (4). Applicants failed to satisfy item (2) of 37 CFR 1.47(a) because documentary evidence discussed in the declaration of Mr. Tsuchiya showing the attempts applicants made to contact Mr. Nakajima was not provided. In the renewed petition, applicants have submitted copies of two letters sent by Mr. Tsuchiya to Mr. Nakajima with accompanying English translations. These letters were sent to the last known address of Mr. Nakajima and Mr. Nakajima's parents respectively. Ren.Pet. ¶ 4. Applicants also submitted copies of emails with accompanying English translations "sent to colleagues of Mr. Nakajima requesting an address for Mr. Nakajima." *Id.* at ¶ 5. Finally, applicants submitted "a copy of an Interoffice Circulate (and accompanying English language translation) sent to the Personnel Division of Mr. Nakajima's employer requesting Mr. Nakajima's address." The last known address of Mr. Nakajima previously submitted was the response received. *Id.*

A review of the documents provided support applicants claim that a diligent effort was made to locate Mr. Nakajima. Accordingly, item (2) is satisfied.

Applicants failed to satisfy item (4) in the initial petition because they submitted a declaration signed by only three of the five listed co-inventors in the initial petition. The name of co-inventor Katsumi Yabuno was not listed on the declaration. The declaration was deemed not acceptable.

In the renewed petition, counsel states that "[a]pplicants submit herewith a Japanese language Declaration (PTO/SB/106)(5 pages) executed by the four available co-inventors." *Id.* at ¶ 7. A review of the declaration provided in the renewed petition shows that all five co-inventors recorded on the international publication are listed as co-inventors. Regardless, the declaration still does not comply with 37 CFR 1.497.

The first two pages of the declaration are listed as "Page 1 of 3" and "Page 2 of 3" respectively. But there appears to be at least two more pages in the declaration listing the five co-inventors. In addition, applicants submitted what appears to be parts of at least two different declarations. The fourth page of the declaration listing the third, fourth, and fifth inventor has been submitted twice. Applicants must submit a copy of the complete declaration signed by each inventor which in this case would require an additional page one, two, and three of the declaration. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. In this case, there is no indication whether every inventor was aware of the other co-inventors listed on the declaration.

Thus, the declaration submitted is not in compliance with 37 CFR 1.497(a)(3) in that it does not properly identify each inventor. Item (4) is still not satisfied.

Accordingly, all the requirements of 37 CFR 1.47(a) are not yet complete.

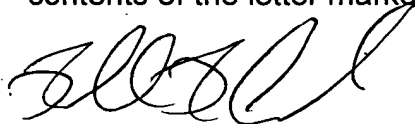
CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

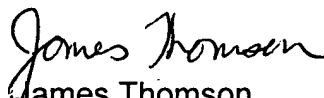
If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the

contents of the letter marked to the attention of the PCT Legal Office.



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